



AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Michael KRIEGER

Application No.: 10/731,113

Filed: December 10, 2003

For: LANTERN WITH INTERNAL
CONVERTER CIRCUIT

Confirmation No.: 4513

Art Unit: 2875

Examiner: Ismael NEGRON

Atty. Docket No.: 32405-199591

Customer No.

26694

PATENT TRADEMARK OFFICE

REPLY BRIEF

Mail Stop: *Appeal Brief - Patents*
Commissioner for Patents
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Sir:

In response to the Examiner's Answer mailed March 19, 2008, the Appellants submit herewith a Reply Brief pursuant to 37 C.F.R. § 41.41. No fee is believed to be due for this Reply Brief, however, should any fees be due, the Patent Office is hereby authorized to charge any necessary fees, or credit any refunds, to our Deposit Account No. 22-0261, referencing our Docket No. 32405-199591.

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I. STATUS OF CLAIMS – 37 C.F.R. § 41.37(c)(1)(iii).

The status of the claims is unchanged from the Appeal Brief. That is, pending claims 14, 16-22, 25 and 27-36 remain finally rejected, and are appealed. Claims 1-13, 15, 23-24, and 26 have been canceled.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL – 37 C.F.R. § 41.37(c)(1)(vi)

These Grounds of Rejection are the same as those set forth in the Appeal Brief and are unchanged.

- A. Whether the Examiner has established that claim 34 is unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- B. Whether the Examiner has established that claims 25 and 27 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,628,339 to Werner (“Werner”).
- C. Whether the Examiner has established that claims 14, 16-19, and 28-29 are unpatentable under 35 U.S.C. § 103(a) over Werner.
- D. Whether the Examiner has established that claims 20-22, 30 and 33-36 are unpatentable under 35 U.S.C. § 103(a) over Werner in view of U.S. Patent No. 6,260,985 to Zeller (“Zeller”).
- E. Whether the Examiner has established that claims 31 and 32 are unpatentable under 35 U.S.C. § 103(a) over Werner in view of Zeller, and further in view of U.S. Patent No. 6,789,924 to Yuen (“Yuen”).

III. Argument – M.P.E.P. § 1208(I); 37 C.F.R. § 41.37(c)(1)(vii)

A. No New Grounds of Rejection Presented in the Examiner’s Answer

The Examiner’s Answer dated March 19, 2008 does not contain a rejection designated as a new ground of rejection, nor does it appear to contain any undesigned new grounds of rejection. *See* M.P.E.P. §§ 1207.03(III)-(IV). Section 9 of the Examiner’s Answer, titled “Grounds of Rejection,” is believed to recite the same grounds of rejection presented in the Final Office Action dated May 11, 2005. Accordingly, the Appellants are not required to exercise the options set forth in 37 C.F.R. §§ 41.39(b)(1)-(2) to avoid *sua sponte* dismissal of the appeal as to claims subject to a new ground of rejection. Nonetheless, the Appellants request that the appeal be maintained by the filing of this Reply Brief, which is submitted in accordance with 37 C.F.R. § 41.41. No new amendments, affidavits, or other evidence are being submitted with this Reply Brief.

B. Reply to Examiner’s “Response to Argument”

Pages 16-17 of the Examiner’s Answer, indicate that Applicant’s arguments regarding the rejection of claim 34 under 35 U.S.C. § 112, second paragraph, have been considered meritorious. With respect to other rejections, Applicant respectfully traverses each of the arguments presented in the Examiner’s Answer “Response to Argument” and provide the following counterarguments.

Pages 17-20 of the Examiner’s Answer respond to the Applicant’s arguments against the prior art, specifically, that Werner fails to render obvious claim 14 under 35 U.S.C. § 103(a). In particular, it is asserted that the although Werner does not teach “an AC-to-DC converter disposed within a second housing … and the second housing being substantially enclosed by the first housing,” as recited in claim 14, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the AC-to-DC converter second and third housings into a single housing to reduce costs and simplify the assembly of Werner’s device. Applicants respectfully disagree.

In embodiments of the present invention, the AC-to-DC converter circuit is substantially enclosed by two housings: one such housing being the housing 144 that

encloses all the circuitry of the converter and another housing being the housing for the lantern or the light source. See Specification, pages 7-8. The second housing is separate and distinct from any of the AC-to-DC converter components and is used to enclose the AC-to-DC converter and all the components therein. The second housing is itself substantially enclosed by a first housing, such as the base 108. Such arrangement allows for the AC-to-DC converter to be separate and independent from the rest of the lantern, allowing, for example, the second housing to be rated for compliance with applicable UL standards without a need to rate the entire lantern. See Specification, page 8, lines 5-9.

In Werner, however, the transformer 80 and rectifier unit 81 are separate components coupled together inside a single housing 75. Thus, even if the transformer 80 and the rectifier unit 81 were combined together, such combination would still fail to teach the claimed *second housing*, as recited in claim 14. The difference between the claimed invention and the disclosure of Werner is not the mere combination of the transformer 80 with the rectifier unit 81. Werner's transformer 80 and rectifier unit 81 do not constitute a *housing*, as stated in the Examiner's Answer, but are mere components of the AC-to-DC converter. In fact, Werner does not include such second housing at all, as recited in claim 14.

Further, it is not obvious to one of ordinary skill in the art to modify Werner to place its AC-to-DC components within a second housing. Providing an additional housing inside the housing 75 of Werner to enclose the transformer 80 and the rectifier unit 81 would only incur additional costs and complicate the design of Werner's device. Thus, one of ordinary skill in the art at the time of the invention would not have modified the device of Werner by providing an additional housing inside the first housing 75 to enclose the transformer 81 and the rectifier unit 80.

The Examiner's Answer states that although Werner fails to explicitly state in the disclosure that the transformer 80 and the rectifier unit 81 are provided within a second housing, it can be inferred from Werner that the transformer 80 and the rectifier unit 81 are not individual and discrete circuit elements, but units packaged within individual housings. There is no evidence to support this conclusion and Applicants respectfully disagree. However, even assuming that the transformer 80 and the rectifier unit 81 each

define their own housing, one of ordinary skill in the art still would have had no motivation to combine the transformer 80 and the rectifier unit 81 into a single housing.

For these reasons, claim 14 is submitted as allowable over Werner. All other claims are submitted as allowable for the reasons provided in the Appeal Brief.

IV. Conclusion

In view of the foregoing arguments, the Applicant respectfully requests reversal of the Examiner's rejections of claims 25 and 27 under 35 U.S.C. § 102(b) as anticipated by Werner. The Applicant further requests reversal of the Examiner's rejections of claims 14, 16-19, 28-29 as unpatentable under 35 U.S.C. § 103(a) over Werner. The Applicant also respectfully requests reversal of the Examiner's rejection of claims 20-22, 30 and 33-36 as unpatentable under 35 U.S.C. § 103(a) over Werner in view of Zeller. The Applicant finally requests reversal of the Examiner's rejection of claims 31-32 as unpatentable under 35 U.S.C. § 103(a) over Werner in view of Zeller, and further in view of Yuen.

Respectfully submitted,

Date: 5/7/08



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DC2-837056